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From: Shawn B. Dempster
No. of Pages: 12 (including cover sheet)
Date: 4 January 2005

Message:

Attached please find:

- PTO Transmittal Form PTO/SB/21;
- Petition Fee Under 37 CFR 1.17(f), (g) & (h) Transmittal (in duplicate for accounting purposes); and
- Petition Under 37 C.F.R. 1.181 to Remove Finality of the Office Action
(8 pages)

If you have any questions, do not hesitate to contact me.

Regards,



Shawn B. Dempster
Reg. No. 34,321

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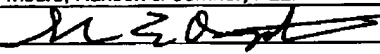
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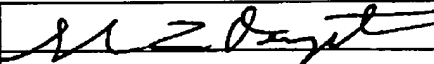
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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/492,844
	Filing Date	Jan 27, 2000
	First Named Inventor	Ronning, Joel A.
	Art Unit	3625
	Examiner Name	Yogesh C. Garg
Total Number of Pages in This Submission	Attorney Docket Number	D33-029-03-US

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form (petition) <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance communication to (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<div style="border: 1px solid black; padding: 2px;">Remarks</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Moore, Hansen & Sumner, PLLP		
Signature			
Printed name	Shawn B. Dempster		
Date	January 4, 2005	Reg. No.	34,321

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Typed or printed name	Shawn B. Dempster	Date	January 4, 2005

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PETITION FEE Under 37 CFR 1.17(f), (g) & (h) TRANSMITTAL (Fees are subject to annual revision)	Application Number	09/492,844
	Filing Date	1/27/2000
	First Named Inventor	Joel A. Ronning
	Art Unit	3625
	Examiner Name	Yogesh C. Garg
Attorney Docket Number		D33-029-03-US

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Enclosed is a petition filed under 37 CFR 1.181 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ the required fee is enclosed.
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Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

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- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1483

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- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.298 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(e) - for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in *inter partes* reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1484

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- § 1.10(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.



Signature

Shawn B. Dempster

Typed or printed name

January 4, 2005

Date

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PETITION FEE Under 37 CFR 1.17(f), (g) & (h) TRANSMITTAL (Fees are subject to annual revision) Send completed form to: Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450	Application Number	09/492,844
	Filing Date	1/27/2000
	First Named Inventor	Joel A. Ronning
	Art Unit	3625
	Examiner Name	Yogesh C. Garg
	Attorney Docket Number	D33-029-03-US

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Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

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- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

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- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in *inter partes* reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.


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Inventor(s): J. Ronning & K. Wical
 Serial No.: 09/492,844 Examiner: Yogesh C. Garg
 Filed: January 27, 2000 Group Art Unit: 3625
 Docket: D33-029-03-US Customer No. 22,854
 Title: Apparatus and Method for Secure Downloading of Files

PETITION UNDER 37 C.F.R. 1.181 TO REMOVE FINALITY OF THE OFFICE ACTION

Mail Stop Petitions
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 P.O. Box 1450
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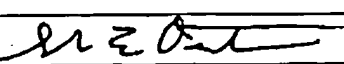
Dear Sir or Madam:

In the Office Action of October 4, 2004, the Examiner for the first time raised two issues, including: (1) whether the Applicant is entitled to a priority claim and alternatively (2) whether the claims are directed to non-statutory subject matter under 35 U.S.C. 101. This petition seeks to remove the finality of the present office action so that the Applicant may fairly address these newly raised issues.

Background

The present application was filed on January 27, 2000 as a continuation-in-part of U.S. Application No. 09/372,253 and further claimed priority to Provisional Application No. 60/110,952. Independent claims 1 and 23 were originally presented as follows:

1. (Original) A method for secure downloading of a file from a network, comprising:
 receiving selection of a file;

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Signature		Date	4 January 2005

receiving an order from a user for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order;
 verifying the file identifier based upon particular information related to the file;
 verifying the order identifier based upon particular information related to the order; and
 selectively downloading the file based upon the verification of the file identifier and the verification of the order identifier.

23. (Original) An apparatus for secure downloading of a file from a network, comprising:

a selection module for receiving selection of a file;
 a receive module for receiving an order from a user for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order;
 a file identifier module for verifying the file identifier based upon particular information related to the file;
 an order identifier module for verifying the order identifier based upon particular information related to the order; and
 a download module for selectively downloading the file based upon the verification of the file identifier and the verification of the order identifier.

A first office action was mailed to the Applicant's first representative on November 20, 2002. The first office action did not contain any objections as to priority claims or non-statutory subject matter under 35 U.S.C. 101.

A response was filed on April 2, 2003, where claims 1 and 23 were amended as follows:

1. (As Amended on 4/2/03) A method for secure downloading of a file from a network, comprising:

receiving selection of a file;
 receiving an order from a user for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order;
 verifying the file identifier based upon particular information related to the file;
 verifying the order identifier based upon particular information related to the order, including:
determining if the order identifier is valid for the order, meaning the order identifier exists for the order;
determining if the order identifier is active, meaning the order was not canceled before the download of the file; and

determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file; and selectively downloading permitting the download of the file based upon the verification of the file identifier and the verification of the order identifier.

23. (As Amended on 4/2/03) An apparatus for secure downloading of a file from a network, comprising:

- a selection module for receiving selection of a file;
- a receive module for receiving an order from a user for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order;
- a file identifier module for verifying the file identifier based upon particular information related to the file;
- an order identifier module for verifying the order identifier based upon particular information related to the order, including:
 - a module for determining if the order identifier is valid for the order, meaning the order identifier exists for the order;
 - a module for determining if the order identifier is active, meaning the order was not canceled before the download of the file; and
 - a module for determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file; and
- a download module for selectively downloading permitting the download of the file based upon the verification of the file identifier and the verification of the order identifier.

A final office action was mailed to the Applicant's second representative on June 13, 2003. Again, this final office action did not contain any objections as to priority claims or non-statutory subject matter under 35 U.S.C. 101.

A request for continuing examination was filed on November 13, 2003, where claims 1 and 23 were amended as follows:

1. (As Amended on 11/13/03) A method for secure downloading of a file from a network, comprising:
 - receiving selection of a file;
 - receiving an order from a user, during an on-line session, for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order;
 - verifying the file identifier based upon particular information related to the file;
 - verifying the order identifier based upon particular information related to the order, including:

determining if the order identifier is valid for the order, meaning the order identifier exists for the order;
determining if the order identifier is active, meaning the order was not canceled before the download of the file during an on-line session; and
determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file during an on-line session; and
selectively permitting the download of the file based upon the verification of the file identifier, the verification of the order identifier, a number of attempted downloads of the file by the user, and a number of successful downloads of the file by the user.

23. (As Amended on 11/13/03) An apparatus for secure downloading of a file from a network, comprising:

- a selection module for receiving selection of a file;
- a receive module for receiving an order, during an on-line session, from a user for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order;
- a file identifier module for verifying the file identifier based upon particular information related to the file;
- an order identifier module for verifying the order identifier based upon particular information related to the order, including:
 - a module for determining if the order identifier is valid for the order, meaning the order identifier exists for the order;
 - a module for determining if the order identifier is active, meaning the order was not canceled before the download of the file during an on-line session; and
 - a module for determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file during an on-line session; and
- a download module for selectively permitting the download of the file based upon the verification of the file identifier, the verification of the order identifier, a number of attempted downloads of the file by the user, and a number of successful downloads of the file by the user.

An office action was mailed to the Applicant's second representative on February 2, 2004. As with the previous two office actions, this office action did not contain any objections as to priority claims or non-statutory subject matter under 35 U.S.C. 101.

A response was filed on July 2, 2004, where claims 1 and 23 were amended as follows:

1. (As Amended on 7/2/04) A method for secure downloading of a file from a network, comprising:
 - receiving selection of a file;

receiving an order from a user, ~~during an on-line session~~, for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order;
 verifying the file identifier based upon particular information related to the file;
 verifying the order identifier based upon particular information related to the order, including:
 determining if the order identifier is valid for the order, meaning the order identifier exists for the order;
 determining if the order identifier is active, meaning the order was not canceled before the download of the file ~~during an on-line session~~; and
 determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file ~~during an on-line session~~; and
 selectively permitting the download of the file based upon the verification of the file identifier, ~~and the verification of the order identifier, a number of attempted downloads of the file by the user, and a number of successful downloads of the file by the user.~~

23. (As Amended on 7/2/04) An apparatus for secure downloading of a file from a network, comprising:

a selection module for receiving selection of a file;
 a receive module for receiving an order from a user, ~~during an on-line session~~, for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order;
 a file identifier module for verifying the file identifier based upon particular information related to the file;
 an order identifier module for verifying the order identifier based upon particular information related to the order, including:
 a module for determining if the order identifier is valid for the order, meaning the order identifier exists for the order;
 a module for determining if the order identifier is active, meaning the order was not canceled before the download of the file ~~during an on-line session~~; and
 a module for determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file ~~during an on-line session~~; and
 a download module for selectively permitting the download of the file based upon the verification of the file identifier, ~~and the verification of the order identifier, a number of attempted downloads of the file by the user, and a number of successful downloads of the file by the user.~~

A final office action was mailed to the Applicant's second representative on October 4, 2004. This final office action, for the very first time, contains objections as to priority claims and non-statutory subject matter under 35 U.S.C. 101. In the October 4, 2004

Office Action, the Examiner stated that "the subject matter of the currently amended independent claims 1 and 23, that is 'permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file the user', is not supported ..." by the prior filed applications. In addition, the Examiner stated in the same Office Action that "the above 101 rejection has arisen due to current amendment by canceling the limitation, 'during the on-line session' from independent claim 1.

On December 7, 2004, subsequent to the aforementioned final Office Action, Applicant transferred the instant application away from the prior second representative to the below signed new representative.

Remarks

In a teleconference on January 4, 2005 between Applicant's representative and the Examiner, the issue of the propriety of the finality of this office action was discussed. No resolution on the issue was achieved. This petition seeks to remove the finality of the present office action dated October 4, 2004, because the Examiner raised a new issue regarding Applicant's priority claim and whether the claims are directed to non-statutory subject matter under 35 U.S.C. 101.

With respect to the prior claim objection, the Examiner did not state that this objection resulted from Applicants amendments to the claims or was as a result of a later filed information disclosure statement as suggested by the examination guidelines set forth in MPEP § 706.07 as the minimum requirement needed to make a second action final. Further, the subject matter of the claims as summarized by the Examiner and repeated above has not changed throughout this prosecution through the patent office since the application was filed January 27, 2000. This issue regarding Applicant's priority claim could have been raised by the Examiner in any one of the three prior Office Actions by the Examiner or at the very least as a new non-final office action. To raise this issue regarding priority claim two years after the first office action and not even permit the Applicant an opportunity to respond to this new issue by right without either appealing or

filing a second request for continuing examination is not fair, contravenes the guidelines set forth in MPEP § 706.07(a) and may even violate sections of the U.S. Administrative Procedures Act. Based on the foregoing, Applicant requests withdrawn of finality of this office action.

With respect to the rejection of the claims as being directed to non-statutory subject matter under 35 U.S.C. 101, the Examiner did state that this objection resulted from Applicants amendments to the claims as suggested by the examination guidelines set forth in MPEP § 706.07 as the minimum requirement needed to make a second action final. However, the particular reason set forth was that the removal of the limitation 'during the on-line session' from independent claim 1 is logically flawed. This particular limitation was first introduced in the third response by the Applicant and then removed in the fourth response. The limitation was not present in the pending claims for the first two office actions issued by the Examiner. As such, this issue regarding 35 U.S.C. 101 could have been timely raised by the Examiner in either the first or second Office Actions by the Examiner or at the very least as a new non-final office action. To raise this issue regarding 35 U.S.C. 101 in a non-timely manner and not even permit the Applicant an opportunity to respond to this new issue by right without either appealing or filing a second request for continuing examination is not fair, contravenes the guidelines set forth in MPEP § 706.07(a) and may even violate sections of the U.S. Administrative Procedures Act. Based on the foregoing, Applicant requests withdrawn of finality of this office action.

If a formal oral hearing or informal telephone interview would help resolve this matter, then the Applicant hereby requests such oral hearing or telephone interview.

On the basis of the foregoing, Applicant respectfully submits that finality of the October 4, 2004 Office Action is premature. The Examiner has raised new issues, for the first time, of whether the Applicant is entitled to a priority claim and alternatively whether the claims are directed to non-statutory subject matter under 35 U.S.C. 101. Applicant respectfully requests that the present petition be granted and the finality of the October 4, 2004 office action be withdrawn.

Should the present petition be granted, the Applicant also requests a refund of the petition fee.

Respectfully submitted,

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Date: 4 January 2005

By 
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